

Office Action Summary

Application No.

09/123,145

Applicant(s)

SEKIGUCHI, KENZO 101262

Examiner

Joseph R. Pokrzywa

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-19,21-30 and 32-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 43-46,56 and 57 is/are allowed.
- 6) ☒ Claim(s) 1-7,9-19,21-30,32-42,47-55,58 and 59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 7/9/02, and has been entered and made of record. Currently, **claims 1-7, 9-19, 21-30, and 32-59** are pending.

Response to Arguments

2. Applicant's arguments filed 7/9/02 have been fully considered but they are not persuasive.

3. In response to applicant's arguments regarding the rejection of amended **claim 1**, which incorporates features originally found in the now canceled claim 8, which state on page 9 that Bloomfield, as discussed in the rejection of claim 8, only discloses that when a time-out condition exists, the telephone call from the fax interface device is ~~hang~~ up, but gives no hint or suggestion to start facsimile reception when time-out condition exists. The examiner notes the current limitation, now in claim 1, which requires a "means for selecting whether the public telephone network is released **or** facsimile reception via the public telephone network is started, when the transfer destination information **or** a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network." Since the claim uses the term "or", which indicates that either one may be executed, starting a facsimile reception when time-out condition exists is not specifically required. Bloomfield teaches of a means for selecting whether the public telephone network is released or facsimile reception via the public telephone

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network is started (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the transfer destination information and a signal related to a facsimile communication are not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network ("time-out" in step 1042, column 17, line 67 through column 18, line 16). Because amended claim 1 further removed the limitation of "by a protocol signal of a facsimile communication protocol and for discriminating the transfer destination information included in the protocol signal", the claim can now be interpreted as being anticipated by Bloomfield. Similarly, using the same arguments noted above, Bloomfield is now used as teaching the newly added elements in amended **claims 13, 25, 36, 37, 54, and 55**, which are similar to that of amended claim 1.

4. In response to applicant's arguments regarding the rejection of **claim 47**, being anticipated by Yamamoto *et al.* (U.S. Patent Number 5,767,985), applicant states on page 10 that Yamamoto fails to teach of "means for receiving another instruction different from the instruction received based on a message return in response to a request from the transmitting source". The examiner notes that the term "instruction" is being interpreted as one of either receiving vocal data in step 116, receiving literal data in step 124, or receiving coded data in step 130. As discussed in the Office action dated 4/9/02, Yamamoto teaches of receiving an instruction, being the received coded data in step 130, generated based on the message, which, in this case, is interpreted as a message indicating image mode in step 128. Further, Yamamoto teaches that different instructions may be received, being either the vocal data in step 116 or the literal data in step 124 in response to the messages instructing vocal mode in 114, or the message

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instructing DTMF/literal data in step 122, respectively. The current claim is worded such that both instructions are not required to be received in the same session. Because of this, one of ordinary skill in the art can interpret Yamamoto as anticipating the claim, since Yamamoto teaches of receiving an instruction generated based on a message, and receiving another instruction, being different from the instruction received, based on the message.

5. Therefore, the rejection of **claim 47**, as cited in the Office action dated 4/9/02, under 35 U.S.C. 102(e), as being anticipated by Yamamoto *et al.*, is maintained and repeated in this Office action. Similarly, for the same reasons discussed above, the rejection of **claims 48-53, 58, and 59**, as cited in the Office action dated 4/9/02, under 35 U.S.C. 102(e), as being anticipated by Yamamoto *et al.*, is maintained and repeated in this Office action.

Claim Objections

6. **Claim 37** is objected to because of the following informalities:

In **claim 37**, lines 9 and 10, "is started" should be removed.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. **Claims 1-3, 5-7, 37-42, 54, and 55** are rejected under 35 U.S.C. 102(e) as being anticipated by Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 4/9/02).

Regarding **claim 1**, Bloomfield discloses a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) comprising a means (data network interface 154) for connecting to a computer network (data network 114, column 4, lines 37 through 67), a means (fax comm interface 130) for connecting to a public telephone network (public telephone network 108, column 4, lines 5 through 20), a means for receiving facsimile image data from the public telephone network (column 5, line 63 through column 6, line 8, and column 6, lines 46 through 65, and column 18, line 54 through column 19, line 10), a means for receiving transfer destination information (fax interface device ID, E-mail destination address, and check sum) of

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e-mail data from the public telephone network (steps 1034, 1036, and 1038 in Fig. 11A, column 17, lines 57 through 63), a means for converting the received facsimile image data into an e-mail data format (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37), a means for designating an e-mail destination of the computer network (E-mail destination address) on the basis of the received transfer destination information (column 18, lines 41 through 54, and column 19, lines 10 through 57), and transmitting the e-mail data converted by the conversion means to a destination designated by the transfer destination information (step 1080 in Fig. 11C, column 19, lines 37 through 45), and a means for selecting whether the public telephone network is released *or* facsimile reception via the public telephone network is started (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the transfer destination information *or* a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network ("time-out" in step 1042, column 17, line 67 through column 18, line 16).

Regarding *claim 2*, Bloomfield discloses the apparatus discussed in claim 1 above, and further teaches that the transmission means comprises destination designation means for designating the e-mail destination (E-mail destination address) of the computer network on the basis of the received transfer destination information (column 18, lines 41 through 54, and column 19, lines 10 through 57), and post-office designation means for designating a desired post-office in an e-mail server (e-mail server 112) of the computer network (column 19, line 46 through column 20, line 11).

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Regarding *claim 3*, Bloomfield discloses the apparatus discussed in claim 1 above, and further teaches that the transfer destination information and password information (identification code) are received from the public telephone network (column 6, lines 30 through 59), wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance (column 16, lines 35 through 39) and if the received password information matches password information set in advance (step 1048, column 18, lines 17 through 48), and the converted e-mail data is transmitted in accordance with the checking results (column 6, line 47 through column 7, line 7).

Regarding *claim 5*, Bloomfield discloses the apparatus discussed in claim 3 above, and further teaches that the password information is received as numeral information (see Figs. 10 and 10A, column 15, lines 30 through 37, column 16, lines 33 through 39).

Regarding *claim 6*, Bloomfield discloses the apparatus discussed in claim 1 above, and further teaches that the transfer destination information is received by a tone signal (column 5, line 63 through column 6, line 17).

Regarding *claim 7*, Bloomfield discloses the apparatus discussed in claim 6 above, and further teaches that the tone signal is a DTMF signal (column 6, line 63 through column 6, line 5, column 10, line 48 through column 11, line 47, and column 14, lines 36 through 38).

Regarding *claim 37*, Bloomfield discloses a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) comprising means for connecting various types of networks (see Fig. 1) which have unique formats and addresses, respectively (column 5, line 63 through column 6, line 46), means for receiving information data (fax interface device ID, E-mail destination address, and check sum) with destination address data via one of the networks from a

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transmission source (steps 1034, 1036, and 1038 in Fig. 11A, column 17, lines 57 through 63), means for changing a format of the information data (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37) and the destination address data into another format corresponding to another type of network by discriminating the destination address data (column 18, lines 41 through 54, and column 19, lines 10 through 57), and means for selecting whether the public telephone network is continued *or not* via the network (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the information data *or* the destination data is not received within a prescribed time for monitoring signal reception from the network after a session is started via the network ("time-out" in step 1042, column 17, line 67 through column 18, line 16).

Regarding *claim 38*, Bloomfield discloses the apparatus discussed in claim 37 above, and further teaches that the types of networks include a computer network (see Fig. 1, and column 4, lines 40 through 55).

Regarding *claim 39*, Bloomfield discloses the apparatus discussed in claim 37 above, and further teaches that the types of networks include a public telephone network (see Fig. 1, public telephone network 108).

Regarding *claim 40*, Bloomfield discloses the apparatus discussed in claim 37 above, and further teaches that the information data is image data in accordance with predetermined image format (column 5, line 52 through column 6, line 46).

Regarding *claim 41*, Bloomfield discloses the apparatus discussed in claim 37 above, and further teaches that the format changing means changes the format from a predetermined format to an e-mail format (column 5, line 52 through column 6, line 46).

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Regarding *claim 42*, Bloomfield discloses the apparatus discussed in claim 37 above, and further teaches that the format changing means changes the format from a facsimile format to a predetermined format (column 5, line 52 through column 6, line 46, and column 7, lines 8 through 28).

Regarding *claim 54*, Bloomfield discloses a method for a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) comprising the steps of connecting various types of networks (see Fig. 1) which have unique formats and addresses, respectively (column 5, line 63 through column 6, line 46), receiving information data (fax interface device ID, E-mail destination address, and check sum) with destination address data via one of the networks from a transmission source (steps 1034, 1036, and 1038 in Fig. 11A, column 17, lines 57 through 63), changing a format of the information data (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37) and the destination address data into another format corresponding to another type of network by discriminating the destination address data (column 18, lines 41 through 54, and column 19, lines 10 through 57), and selecting whether the public telephone network is continued *or not* via the network (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the information data *or* the destination data is not received within a prescribed time for monitoring signal reception from the network after a session is started via the network ("time-out" in step 1042, column 17, line 67 through column 18, line 16).

Regarding *claim 55*, Bloomfield discloses a computer program (column 6, lines 18 through 27) for a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) comprising computer readable program code means for connecting various types of networks

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(see Fig. 1) which have unique formats and addresses, respectively (column 5, line 63 through column 6, line 46), receiving information data (fax interface device ID, E-mail destination address, and check sum) with destination address data via one of the networks from a transmission source (steps 1034, 1036, and 1038 in Fig. 11A, column 17, lines 57 through 63), changing a format of the information data (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37) and the destination address data into another format corresponding to another type of network by discriminating the destination address data (column 18, lines 41 through 54, and column 19, lines 10 through 57), and selecting whether the public telephone network is continued *or not* via the network (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the information data *or* the destination data is not received within a prescribed time for monitoring signal reception from the network after a session is started via the network ("time-out" in step 1042, column 17, line 67 through column 18, line 16).

9. **Claims 47-53, 58, and 59** are rejected under 35 U.S.C. 102(e) as being anticipated by Yamamoto *et al.* (U.S. Patent Number 5,767,985, cited in the Office action dated 4/9/02).

Regarding *claim 47*, Yamamoto discloses a communication apparatus (fax unit 30) comprising a means for connecting various types of networks which have unique formats and addresses, respectively (see Figs. 1 and 2), means for receiving information data (vocal guide message data in step 104 in Fig. 3, column 8, lines 17 through 41, whereby the message data is received by the fax unit 30 from the host unit 10) with destination address data from a transmitting source via the networks (column 8, lines 17 through 41, wherein the vocal guide

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message includes a message stating "Specify an E-mail destination in any form..."), means for returning a message in response to a request from the transmitting source (being the host unit 10) via the networks (being one of steps 114, 122, or 128 in Fig. 3, column 8, lines 66 through 28), means for receiving an instruction generated based on the message (being step 130, column 9, lines 21 through 40), means for receiving another instruction different from the instruction based on the message (being steps 116 or 124, column 9, lines 29 through 36), means for processing the information data without changing the format in a case where the another instruction is received (steps 118 and 126, column 9, lines 29 through 36, as well as seen in Fig. 5 as "no" in all of the steps 228, 236, 242, 250, 256, and 262), and means for changing a format of the information data and the destination address data into another format corresponding to another type of network in accordance with the received instruction (step 130, column 9, lines 21 through 40, whereby received data is decoded, as well as seen in Fig. 5 as "yes" to any of steps 228, 236, 242, 250, 256, and 262).

Regarding *claims 48*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the means for returning returns the message as voice guidance information (column 8, line 62 through column 9, line 28).

Regarding *claim 49*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the means for receiving an instruction receives the instruction by a tone signal (column 9, lines 21 through 40).

Regarding *claim 50*, Yamamoto discloses the apparatus discussed above in claim 49, and further teaches that the tone signal is a DTMF signal (column 9, lines 21 through 40).

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Regarding *claim 51*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the information data is image data in accordance with a predetermined image format (column 9, lines 15 through 27).

Regarding *claim 52*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the means for changing the format changes the format from a predetermined format to an e-mail format (see Fig. 5).

Regarding *claim 53*, Yamamoto discloses the apparatus discussed above in claim 47, and further teaches that the means for changing a format changes the format from a facsimile format to a predetermined format (see Fig. 5).

Regarding *claim 58*, Yamamoto discloses method for a communication apparatus (fax unit 30) comprising connecting various types of networks which have unique formats and addresses, respectively (see Figs. 1 and 2), receiving information data (vocal guide message data in step 104 in Fig. 3, column 8, lines 17 through 41, whereby the message data is received by the fax unit 30 from the host unit 10) with destination address data from a transmitting source via the networks (column 8, lines 17 through 41, wherein the vocal guide message includes a message stating "Specify an E-mail destination in any form..."), returning a message in response to a request from the transmitting source (being the host unit 10) via the networks (being one of steps 114, 122, or 128 in Fig. 3, column 8, lines 66 through 28), receiving an instruction generated based on the message (being step 130, column 9, lines 21 through 40), receiving another instruction different from the instruction based on the message (being steps 116 or 124, column 9, lines 29 through 36), processing the information data without changing the format in a case where the another instruction is received (steps 118 and 126, column 9, lines 29 through 36, as

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well as seen in Fig. 5 as “no” in al of the steps 228, 236, 242, 250, 256, and 262), and changing a format of the information data and the destination address data into another format corresponding to another type of network in accordance with the received instruction (step 130, column 9, lines 21 through 40, whereby received data is decoded, as well as seen in Fig. 5 as “yes” to any of steps 228, 236, 242, 250, 256, and 262).

Regarding *claim 59*, Yamamoto discloses a computer program (column 7, lines 28 through 31) for a communication apparatus (fax unit 30) comprising a means for connecting various types of networks which have unique formats and addresses, respectively (see Figs. 1 and 2), means for receiving information data (vocal guide message data in step 104 in Fig. 3, column 8, lines 17 through 41, whereby the message data is received by the fax unit 30 from the host unit 10) with destination address data from a transmitting source via the networks (column 8, lines 17 through 41, wherein the vocal guide message includes a message stating “Specify an E-mail destination in any form...”), means for returning a message in response to a request from the transmitting source (being the host unit 10) via the networks (being one of steps 114, 122, or 128 in Fig. 3, column 8, lines 66 through 28), means for receiving an instruction generated based on the message (being step 130, column 9, lines 21 through 40), means for receiving another instruction different from the instruction based on the message (being steps 116 or 124, column 9, lines 29 through 36), means for processing the information data without changing the format in a case where the another instruction is received (steps 118 and 126, column 9, lines 29 through 36, as well as seen in Fig. 5 as “no” in al of the steps 228, 236, 242, 250, 256, and 262), and means for changing a format of the information data and the destination address data into another format corresponding to another type of network in accordance with the received instruction

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(step 130, column 9, lines 21 through 40, whereby received data is decoded, as well as seen in Fig. 5 as "yes" to any of steps 228, 236, 242, 250, 256, and 262).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. **Claims 4, and 9-12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 4/9/02) in view of Toyoda *et al.* (U.S. Patent Number 5,812,278, cited in the Office action dated 4/9/02).

Regarding **claim 4**, Bloomfield discloses the apparatus discussed in claim 1 above, but fails to specifically teach of a means for registering in advance e-mail address information of the e-mail destination in correspondence with numeral information, wherein the transfer destination information is received as numeral information, and the address information of the e-mail destination corresponding to the received numeral information is read out from the storage means to designate the e-mail destination. Toyoda discloses a communication apparatus (facsimile apparatus 71, 81, or 91, seen in Fig. 21) comprising a means (LAN control unit 78, seen in Fig. 22) for connecting to a computer network (LAN or Internet 65), a means (facsimile data communicating unit 74) for connecting to a public telephone network (PSTN 63), a means for receiving facsimile image data from the public telephone network (S201 in Fig. 23, column 22, lines 6 through 13), a means for receiving transfer destination information of e-mail data

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from the public telephone network (PSTN 63, column 21, lines 1 through 17, and column 22, lines 1 through 39), a means for converting the received facsimile image data into an e-mail data format (column 22, lines 40 through 54), and a means for designating an e-mail destination of the computer network on the basis of the received transfer destination information (column 22, lines 40 through 49), and transmitting the e-mail data converted by the conversion means to a destination designated by the transfer destination information (column 22, lines 49 through 67). Toyoda further teaches of a means for registering in advance e-mail address information of the e-mail destination in correspondence with numeral information (column 22, lines 27 through 39), wherein the transfer destination information is received as numeral information (column 22, lines 27 through 39), and the address information of the e-mail destination corresponding to the received numeral information is read out from the storage means to designate the e-mail destination (column 22, lines 40 through 59). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Toyoda's teachings in the system of Bloomfield. Bloomfield's system would easily be modified to include Toyoda's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 9*, Bloomfield and Toyoda disclose the apparatus discussed in claim 4 above, and Toyoda further teaches that the transfer destination information is received by a protocol signal of a facsimile communication protocol (column 21, line 1 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Toyoda's teachings in the system of Bloomfield. Bloomfield's system would easily be modified to include Toyoda's teachings, as the systems share cumulative features, being additive in nature.

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Regarding *claim 10*, Bloomfield discloses the apparatus discussed in claim 5 above, and further teaches that the password information is received by a protocol signal of a facsimile communication protocol (column 17, line 53 through column 18, line 66). However, Bloomfield fails to specifically teach of receiving identification information by a protocol signal of a facsimile communication protocol. Toyoda discloses a communication apparatus, discussed above in claim 4, (being facsimile apparatus 71, 81, or 91, seen in Fig. 21), further comprising of receiving identification information by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Toyoda's teachings in Bloomfield's system. Bloomfield's system would easily be modified to include Toyoda's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 11*, Bloomfield and Toyoda disclose the apparatus discussed above in claim 9, and Toyoda further teaches that that the protocol signal of the facsimile communication protocol is a subaddress signal or selective polling signal of the T.30 recommendation (column 21, lines 1 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Toyoda's teachings in the system of Bloomfield. Bloomfield's system would easily be modified to include Toyoda's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 12*, Bloomfield and Toyoda disclose the apparatus discussed above in claim 10, and Toyoda further teaches that that the protocol signal of the facsimile communication protocol is a password signal of the T.30 recommendation (column 21, lines 1 through 17). Therefore, it would have been obvious to a person of ordinary skill in the art at the

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time the invention was made to include Toyoda's teachings in Bloomfield's system.

Bloomfield's system would easily be modified to include Toyoda's teachings, as the systems share cumulative features, being additive in nature.

12. **Claims 13-19, 21-30, and 32-36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda *et al.* (U.S. Patent Number 5,812,278, cited in the Office action dated 4/9/02) in view of Bloomfield (U.S. Patent Number 6,025,931, cited in the Office action dated 4/9/02).

Regarding **claim 13**, Toyoda discloses a method for a communication apparatus (facsimile apparatus 71, 81, or 91, seen in Fig. 21), connected to a computer network (LAN or Internet 65) and a public telephone network (PSTN 63), the communication apparatus having a facsimile communication function (column 21, lines 29 through 33), with the method comprising the steps of receiving a remote instruction including transfer destination information from the public telephone network by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17, and column 22, lines 1 through 39), receiving facsimile image data from the public telephone network (S201 in Fig. 23, column 22, lines 6 through 13), converting the received facsimile image data into an e-mail data format (column 22, lines 40 through 54), designating an e-mail destination of the computer network based on the received transfer destination information (column 22, lines 40 through 49), and transmitting the converted e-mail data to a destination designated by the transfer destination information (column 22, lines 49 through 67).

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However, Toyoda fails to specifically teach of selecting whether the public telephone network is released or facsimile reception via the public telephone network is started, when the transfer destination information or a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network. Bloomfield discloses a method for a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) connected to a computer network (data network 114, column 4, lines 37 through 67) and a public telephone network (public telephone network 108, column 4, lines 5 through 20), with the communication apparatus having a facsimile communication function, and the method comprising the steps of receiving facsimile image data from the public telephone network (column 5, line 63 through column 6, line 8, and column 6, lines 46 through 65, and column 18, line 54 through column 19, line 10), converting the received facsimile image data into an e-mail data format (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37), designating an e-mail destination of the computer network (E-mail destination address) based on the received transfer destination information (column 18, lines 41 through 54, and column 19, lines 10 through 57), and transmitting the e-mail data converted by the conversion means to a destination designated by the transfer destination information (step 1080 in Fig. 11C, column 19, lines 37 through 45), and selecting whether the public telephone network is released *or* facsimile reception via the public telephone network is started (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the transfer destination information *or* a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone

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network ("time-out " in step 1042, column 17, line 67 through column 18, line 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in the system of Toyoda. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 25*, Toyoda discloses a storage medium (ROM 72) which stores a computer program executed by a computer of a communication apparatus (facsimile apparatus 71, 81, or 91, seen in Fig. 21, column 21, lines 20 through 27), connected to a computer network (LAN or Internet 65) and a public telephone network (PSTN 63), the communication apparatus having a facsimile communication function (column 21, lines 29 through 33), with the computer program having processing of receiving a remote instruction including transfer destination information from the public telephone network by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17, and column 22, lines 1 through 39), processing of receiving facsimile image data from the public telephone network (S201 in Fig. 23, column 22, lines 6 through 13), processing of converting the received facsimile image data into an e-mail data format (column 22, lines 40 through 54), processing of discriminating the transfer destination information included in the protocol signal (column 22, lines 1 through 16), and processing of designating an e-mail destination of the computer network on the basis of the discriminated transfer destination information (column 22, lines 40 through 49), and transmitting the converted e-mail data to a destination designated by the transfer destination information (column 22, lines 49 through 67).

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However, Toyoda fails to specifically teach of selecting whether the public telephone network is released or facsimile reception via the public telephone network is started, when the transfer destination information or a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network. Bloomfield discloses a storage medium which stores a computer program (column 6, lines 18 through 27) executed by a computer of a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) connected to a computer network (data network 114, column 4, lines 37 through 67) and a public telephone network (public telephone network 108, column 4, lines 5 through 20), with the communication apparatus having a facsimile communication function, and the computer program having the processings of receiving facsimile image data from the public telephone network (column 5, line 63 through column 6, line 8, and column 6, lines 46 through 65, and column 18, line 54 through column 19, line 10), converting the received facsimile image data into an e-mail data format (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37), designating an e-mail destination of the computer network (E-mail destination address) based on the received transfer destination information (column 18, lines 41 through 54, and column 19, lines 10 through 57), transmitting the e-mail data converted by the conversion means to a destination designated by the transfer destination information (step 1080 in Fig. 11C, column 19, lines 37 through 45), and selecting whether the public telephone network is released *or* facsimile reception via the public telephone network is started (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the transfer destination information *or* a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception

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from the public telephone network after call reception from the public telephone network ("time-out" in step 1042, column 17, line 67 through column 18, line 16). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in the system of Toyoda. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 14 and 26*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 13 and 25, respectively, and Bloomfield further teaches that the transfer destination information and password information (identification code) are received from the public telephone network (column 6, lines 30 through 59), wherein it is checked if e-mail transfer destination information corresponding to the transfer destination information is set in advance (column 16, lines 35 through 39) and if the received password information matches password information set in advance (step 1048, column 18, lines 17 through 48), and the converted e-mail data is transmitted in accordance with the checking results (column 6, line 47 through column 7, line 7). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 15 and 27*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Toyoda further teaches that the step of designating the e-mail destination of the computer network on the basis of the received transfer destination information (column 22, lines 1 through 49), and designating a desired post-office in

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an e-mail server (personal computer 64) of the computer network (column 22, lines 49 through column 23, line 4, and column 10, lines 40 through 53, wherein the electronic mail is transmitted according to post office protocol, thereby having the personal computer 64 receive the email in a "post office" corresponding to the designated e-mail destination).

Regarding *claims 16 and 28*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Toyoda further teaches of registering in advance e-mail address information of the e-mail destination in storage means in correspondence with numeral information (column 22, lines 27 through 39), and receiving the transfer destination information as numeral information (column 22, lines 27 through 39), and reading out the address information of the e-mail destination corresponding to the received numeral information from the storage means to designate the e-mail destination (column 22, lines 40 through 59).

Regarding *claims 17 and 29*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Bloomfield further teaches that the password information is received as numeral information (see Figs. 10 and 10A, column 15, lines 30 through 37, column 16, lines 33 through 39). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claim 18*, Toyoda and Bloomfield disclose the method discussed in claim 14 above, and Toyoda further teaches that the transfer destination information is received by a tone signal (column 21, lines 1 through 17, and column 22, lines 1 through 39).

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Regarding *claims 19 and 30*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 18 and 26, respectively, and Bloomfield further teaches that the transfer destination information is received by a tone signal (column 5, line 54 through column 6, line 8, and column 10, line 48 through column 11, line 47), whereby the tone signal is a DTMF signal (column 6, line 63 through column 6, line 5, column 10, line 48 through column 11, line 47, and column 14, lines 36 through 38). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Regarding *claims 21 and 32*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Toyoda further teaches that the transfer destination information is received by a protocol signal of a facsimile communication protocol (column 21, line 1 through 17).

Regarding *claims 22 and 33*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 14 and 26, respectively, and Toyoda further teaches of receiving identification information by a protocol signal of a facsimile communication protocol (column 21, lines 1 through 17). Further, Bloomfield teaches that the password information is received by a protocol signal of a facsimile communication protocol (column 17, line 53 through column 18, line 66). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in Toyoda's system. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

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Regarding *claims 23 and 34*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 21 and 26, respectively, and Toyoda further teaches that that the protocol signal of the facsimile communication protocol is a subaddress signal or selective polling signal of the T.30 recommendation (column 21, lines 1 through 17).

Regarding *claims 24 and 35*, Toyoda and Bloomfield disclose the method and medium discussed above in claims 22 and 26, respectively, and Toyoda further teaches that that the protocol signal of the facsimile communication protocol is a password signal of the T.30 recommendation (column 21, lines 1 through 17).

Regarding *claim 36*, Toyoda discloses a communication system including a communication apparatus (facsimile apparatus 71, 81, or 91, seen in Fig. 21, and see facsimile apparatus 51 in Figs. 3 and 12) which is connected to a computer network (LAN or Internet 65) and a public telephone network (PSTN 63), with the communication apparatus having a facsimile communication function (column 21, lines 29 through 33), the computer network (LAN or Internet 65) having an e-mail server (personal computer 64), wherein the communication apparatus (facsimile apparatus 71) receives facsimile image data from the public telephone network (PSTN 63) upon reception of a remote instruction including transfer destination information from the public telephone network on the basis of a facsimile communication (column 22, lines 1 through 39), converts the received facsimile image data into an e-mail data format (column 22, lines 40 through 54), transmits the e-mail data by designating an e-mail destination based on the received transfer destination (column 22, lines 54 through 59), and the e-mail server (personal computer 64) receives the transmitted e-mail data in a post-office corresponding to the e-mail destination (column 22, lines 49 through column 23, line 4, and

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column 10, lines 40 through 53, wherein the electronic mail is transmitted according to post office protocol, thereby having the personal computer 64 receive the email in a "post office" corresponding to the e-mail destination).

However, Toyoda fails to specifically teach of selecting whether the public telephone network is released or facsimile reception via the public telephone network is started, when the transfer destination information or a signal related to a facsimile communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network. Bloomfield discloses a communication system including a communication apparatus (fax server 110, seen in Figs. 1, 2, and 13) which is connected to a computer network (data network 114, column 4, lines 37 through 67) and a public telephone network (public telephone network 108, column 4, lines 5 through 20), with the communication apparatus having a facsimile communication function, the computer network having an e-mail server (e-mail server 112), wherein the communication apparatus receives facsimile image data from the public telephone network (column 5, line 63 through column 6, line 8, and column 6, lines 46 through 65, and column 18, line 54 through column 19, line 10), converts the received facsimile image data into an e-mail data format (column 6, line 66 through column 7, line 34, steps 1070 and 1072 in Fig. 11C, and column 19, lines 10 through 37), transmits the e-mail data by designating an e-mail destination (E-mail destination address) based on the received transfer destination information (column 18, lines 41 through 54, and column 19, lines 10 through 57), and selects whether the public telephone network is released *or* facsimile reception via the public telephone network is started (steps 1046 or 1044 in Fig. 11B, column 18, lines 7 through 16), when the transfer destination information *or* a signal related to a facsimile

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communication is not received within a prescribed time for monitoring signal reception from the public telephone network after call reception from the public telephone network ("time-out " in step 1042, column 17, line 67 through column 18, line 16), the e-mail server receives the transmitted e-mail data in a post office corresponding to the e-mail destination (see Figs. 11C and 12, column 19, line 37 through column 20, line 11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include Bloomfield's teachings in the system of Toyoda. Toyoda's system would easily be modified to include Bloomfield's teachings, as the systems share cumulative features, being additive in nature.

Allowable Subject Matter

13. **Claims 43-46, 56 and 57** are allowed.

14. The following is a statement of reasons for the indication of allowable subject matter:

Regarding independent *claims 43, 56, and 57*, in the examiner's opinion, it would not have been obvious to a person of ordinary skill in the art at the time the invention was made to have a system receive facsimile image data from a transmitting source via the public telephone network, return a message in response to a request received from the transmitting source via the public telephone network, receive a first instruction generated based on the message returned by the returning means, receive a second instruction that indicates a facsimile communication without reception of the first instruction, convert the received facsimile image data into an e-mail data format, process the received facsimile image data without performing the converting in a case where the second instruction is received, and then transmitting the converted e-mail data. The closest prior art, Bloomfield (U.S. Patent Number 6,025,931), as well as Yamamoto *et al.*

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(U.S. Patent Number 5,767,985) fail to teach of all these features in the limitations, particularly the limitations of receiving a second instruction that indicates a facsimile communication without reception of the first instruction, and processing the received facsimile image data without performing the converting in a case where the second instruction is received, which were added in the amendment dated 12/19/01. Because of this, the claims are rendered allowable.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joe Pokrzywa whose telephone number is (703) 305-0146. The examiner can normally be reached on Monday-Friday, 7:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (703) 305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

J. R. P.

Joseph R. Pokrzywa
Examiner
Art Unit 2622

jrj
September 28, 2002

MaDeleine Nguyen

**MADELEINE NGUYEN
PATENT EXAMINER**

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